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Date: May 13, 2005

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Name William T. Leader Technology Center 1700, Art Unit 1742 U.S. Patent and Trademark Office	703-872-9306	

From:	Gavin J. Milczarek-Desai	520-770-2235	520-770-8716
Re:	APPLICANT: M. Michael Pitts, Jr. et al.	DOCKET NO.: 111732.00012	
	SERIAL NO.: 10/796,814	EXAMINER: William T. Leader	
	FILED: March 9, 2004	ART UNIT: 1742	
	TITLE: CAPACITIVE ELECTROSTATIC PROCESS FOR INHIBITING THE FORMATION OF BIOFILM DEPOSITS IN MEMBRANE-SEPARATION SYSTEMS		

Attachment(s): **Transmittal of Terminal Disclaimer**  
**Terminal Disclaimer signed by attorney of record**

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: M. Michael Pitts, Jr. et al.

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TITLE: CAPACITIVE ELECTROSTATIC PROCESS FOR INHIBITING THE FORMATION  
OF BIOFILM DEPOSITS IN MEMBRANE-SEPARATION SYSTEMS

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Antonio R. Durando  
Quarles & Brady Streich Lang  
One South Church Avenue, Suite 1700  
Tucson, AZ 85701

## CERTIFICATE OF TRANSMISSION

I hereby certify that on this 13<sup>th</sup> day of May, 2005, this correspondence is being transmitted to the attention of Examiner William T. Leader, via facsimile (703-872-9306) to the U.S. Patent and Trademark Office, Patent Technology Center 1700, Art Unit 1742.

By: Alice B. Vanicek  
Alice B. Vanicek

TO THE COMMISSIONER FOR PATENTS

## Transmittal of Terminal Disclaimer

Dear Sir:

Further to applicant's Supplementary Response and petition for three-months extension of time filed on May 10, 2005, and in response to the communication dated May 9, 2005, from Examiner Leader stating the reply filed on March 9, 2005, is not fully responsive to the prior Office Action,

S.N. 10/796,814

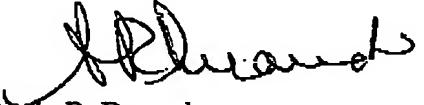
Art Unit 1742

attached is a Terminal Disclaimer signed by the undersigned attorney, who is of record in the subject application

A fee authorization form for the terminal disclaimer fee under 37 CFR 1.20(d) was submitted in the previous Response. A petition for a 3-month extension of time was submitted with the documents filed May 10, 2005. Should there be any additional or unforeseen costs, please charge our Deposit Account No. 17-0055.

Respectfully submitted,

Quarles & Brady Streich Lang LLP



Antonio R. Durando  
Reg. No. 28,409

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TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING  
REJECTION OVER A "PRIOR" PATENTDocket Number (Optional)  
111732.00012

In re Application of: M. Michael Pitts, Jr. and Rodrigo F.V. Romo

Application No.: 10/796,814

Filed: March 9, 2004

For: Capacitive Electrostatic Process for Inhibiting the Formation of Biofilm Deposits in Membrane-Separation Systems

The owner(s) M. Michael Pitts, Jr. and Rodrigo F.V. Romo of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term prior patent No. 5,591,317 as the term of said prior patent is defined in 35 U.S.C. 154 and 173, and as the term of said prior patent is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the prior patent, "as the term of said prior patent is presently shortened by any terminal disclaimer," in the event that said prior patent later

expires for failure to pay a maintenance fee;  
is held unenforceable;  
is found invalid by a court of competent jurisdiction;  
is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;  
has all claims canceled by a reexamination certificate;  
is reissued; or  
is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1.  For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2.  The undersigned is an attorney or agent of record. Reg. No. 28,409

  
Signature \_\_\_\_\_ Date May 12, 2005

Antonio R. Durando  
Typed or printed name

520-770-8700  
Telephone Number

Terminal disclaimer fee under 37 CFR 1.20(d) included. Please charge the terminal disclaimer fee of \$65.00 (small entity) to Deposit Account No. 17-0055.  
WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

\*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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